

REMARKS

Applicants wish to thank the Examiner for a thorough review and consideration for the subject application. The Non-Final Office Action of March 26, 2003 has been received and its contents carefully noted. By this amendment, claims 1-17 have been amended and are currently pending in the application, of which claims 1, 6, and 12 are independent claims.

In the Office Action, claim 6 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 6 and 20 of co-pending Application No. 09/802,828; claims 1 and 3-5 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 6 and 20 of co-pending Application No. 09/802,828 without reference to any particular claims; and claims 1-17 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,003,506 issued to Klett ("Klett") in view of U.S. Patent No. 3,309,437 issued to Harnett ("Harnett"). Applicants respectfully traverse these rejections and in view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Provisional Obviousness Type Double Patenting

Claims 1, 3-5, and 6 collectively stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Application No. 09/802,828. Before consideration can be given to the issue of double patenting, there must be some common relationship and/or ownership to Application No. 09/802,828 having a title "Iteration

Terminating using Quality Index Criteria of Turbo Codes.” In the present case, there is no common relationship or ownership. Accordingly, Applicants respectfully submit any obviousness type-double patenting is improper.

Rejections Under 35 U.S.C. §103

Claims 1-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Klett in view of Harnett. Applicants respectfully traverse this rejection for at least the following reasons.

The Examiner has taken the position the Klett teaches a process for producing pitch based foam and pitch based foam that renders the instant claims obvious referring to the abstract, example 1 and the claims. The Examiner further asserts that Klett would have a density from 0.1 to 0.8 g/cm³ in view of the teaching of Harnett to render the claims obvious. The Examiner asserts that Harnett teaches a porous based product having a compressive strength typically in excess of 5000 psi when heated to 950°C and an apparent density of 0.93g/cc and further graphitizing which anticipate the instant claims. The apparent density of 0.93 g/cc renders obvious the apparent density of 0.1 to about 0.8 g/ cm³. The Examiner further takes the position that 0.8 reads on 0.93 g/cc. The grounds for this rejection is unclear. The rejection states that Harnett anticipates claims 1-4 and then refers to rendering obvious the apparent density of 0.1 to 0.8 g/ cm³. Applicants respectfully request clarification and support for the grounds for rejection.

Claim 1 of the present application is directed to using mesophase carbon derived from a petroleum or coal tar pitch having a softening point above about 300°C. The mesophase carbon material is derived from petroleum pitch or coal tar pitch. Mesophase carbon is not the same as a pitch and has a softening point above about 300°C. In contrast, Klett is directed to forming

carbon foam from pitches that have softening points below 300°C. Klett teaches heating the pitch 50 to 100°C above the softening point of the pitch. (Column 3, lines 24-25). The pitch used in Klett was Mitsubishi ARA24 mesophase pitch which was heated to 300°C. (Column 4, lines 24-26.) Accordingly the materials in Klett have a softening point below 300°C, and are not the same materials as the claimed mesophase carbon material in claim 1. Harnett fails to cure this deficiency as Harnett is directed to using raw petroleum coke. For at least the foregoing reasons, Applicants respectfully submit that claim 1 and claims 2-5, which depend from claim 1 are allowable.

Claim 6 is allowable over the cited references in that claim 6 recites a combination of elements including, for example, "a method for producing a carbon foam from a mesophase carbon particulate derived from a petroleum or coal tar pitch exhibiting a softening point above about 300° C, comprising: placing mesophase carbon particulate in a mold; heating said mesophase carbon particulate in said mold under a non-oxidizing atmosphere to a temperature ranging from about 300° C to about 700° C and soaking at this temperature for a period of from about 10 minutes to about 1 hour to form a green foam; and controllably cooling said green foam." None of the cited references either singly or in combination teaches or suggests at least these features. For at least the foregoing reasons, Applicants respectfully submit that claim 6 and claims 7-11, which depend from claim 6 are allowable.

Claim 12 is allowable over the cited references in that claim 12 recites a combination of elements including, for example, "a porous pitch-based foam produced from a mesophase carbon derived from a petroleum or coal tar pitch exhibiting a softening point above about 300° C, and having a density of ranging from about 0.1 to about 0.8 g/cm³ produced by a method comprising: placing mesophase carbon particulate in a mold; heating said mesophase carbon particulate in

said mold under a non-oxidizing atmosphere to a temperature of ranging from about 300° C to about 700° C to form a foam. For at least the foregoing reasons, Applicants respectfully submit that claim 12 and claims 13-17, which depend from claim 12 are allowable.

Additionally, in levying an obviousness rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. See MPEP § 2143 (8th Ed., Rev. Feb. 2003). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner's burden in levying an obviousness rejection is discussed above. The Federal Circuit recently emphasized the importance of evidencing the requisite motivation to combine references when rejecting claims based upon obviousness. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In the present case, the Examiner has failed to make the requisite showing, as articulated in *Lee* and its predecessors, of a motivation to combine Klett and Harnett. As discussed above, among other things, Klett and Harnett use different starting materials and form different products. Given the opposite teachings of Harnett and Klett, one skilled in the art would not be motivated to combine Harnett and Klett with any reasonable expectation of success. Accordingly, the Examiner as failed to establish a *prima facie* case of obviousness and Applicants respectfully request the rejection under § 103 be withdrawn.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-17. Since the none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants

respectfully submit that independent claims 1, 6, and 12, and all the claims that depend therefrom are allowable.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



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